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09/182,745

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/182,745 10/28/98 MACLEOD BECK & C P3316

EXAMINER

LM02/0113

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ART UNIT

PAPER NUMBER

2776

4

DATE MAILED:

01/13/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/182,745

Applicant(s)  
Beck et al.

Examiner  
Cong-Lac Huynh

Group Art Unit  
2776



☒ Responsive to communication(s) filed on Oct 28, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-20 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-20 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## **DETAILED ACTION**

### ***Drawings***

1. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

### ***Specification***

2. The abstract of the disclosure is objected to because in the sentence "In the programming application...IMA." (lines 12-14), there is one extra word "programmer". Correction is required.

### ***Claim Objections***

3. Claims 1 and 11 are objected to because of the following informalities:

-- In claim 1, line 9, "ofaccess" should be separated as "of access"

-- In claim 11,

line 11, the word "A" in "A programming application..." can not be capitalized because it is in the middle of the sentence

line 20, there are two successive words "access"

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 6, 11, 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 6 (line 5), claim 11 (line 16) and claim 16 (line 17), the phrase "other than" in "...providing functionality for an Interactive Multimedia Application *other than* access to and rendering of the multimedia files,..." is indefinite. It is not clear what "functionality" is.

***Claim Rejections - 35 USC § 101***

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 1-15 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

The claims is not directed to statutory subject matter because the claimed subject matter:

(1) does not fall within one of the four statutory classes of inventions under § 101;  
and/or

(2) falls within the mere idea or abstract intellectual concept exception to § 101; and/or

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(3) falls, by analogy, within the printed matter exception to § 101.

"A software Interactive Media Viewer module comprising a code set and an editable layer, and a programming application for creating an Interactive Multimedia Application" that are not in a "computer readable medium" are considered non-statutory subject matters by analogy to the "printed matter" exception under § 101. Therefore, it is insisted that the claim must explicitly state that the method is stored on a computer readable medium. See *MPEP 2106(1)(ii) Patentable Subject Matter - Computer-Implemented Inventions*.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was

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made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 1-2, 6-7, 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Syeda-Mahmood (US Pat No. 5,983,218, 11/9/99) in view of Torres et al. (US Pat No. 5,897,635, 4/27/99).

Regarding independent claim 16, Syeda-Mahmood discloses:

-- selecting first selectable software modules providing functionality for an Interactive Multimedia Application (IMV) other than access and rendering of the multimedia files (this disclosure is about the design of multimedia databases (col 3, lines 61-64); a computational framework is presented for the design of multimedia ...methods for index creation on multimedia content, image and video data, to enable the descriptions of the database queries.. direct interactive dialog between the web client and multimedia database (col 4, lines 10-30))

-- selecting at least one selectable Interactive Multimedia Viewer software module including a code set adapted to access and render media code from multimedia files in a data repository (the invention is part of a web-based multimedia retrieval system...the design of a web server that can *select and coordinate information flow* between the database sites and the user sites (col 4, lines 4-10))

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Syeda-Mahmood does not disclose the editing of the editable layer of at least one IMV and the joining of selected and edited modules to form the IMV.

Torres discloses:

- the accessing and rendering media from multimedia files in a data repository (a new file format ...allows various type and subtypes of multimedia information....corresponding method of access and processing (col 5, lines 10-17) and an editable layer to program limitations limiting access to preselected media files (A set of generic rules will be constructed to conduct the refinement of the site relevancy of query-data patterns extracted from the web database sites (col 7, lines 50-53))
- edit the editable layer of the at least one IMV (the file format allows media instances to be added and deleted to a file ...presentations (col 5, lines 28-35))
- joining the selected and edited modules to form the IMA (the file format allows media instances to be added and deleted to a file ....maintain large, complicated multimedia presentations (col 5, lines 28-35))

Though both Syeda-Mahmood and Torres do not use the terms the software modules and Interactive Multimedia Viewer as claimed, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Syeda-Mahmood into Torres since the system of Syeda-Mahmood and Torres show the accessing and rendering of the multimedia files as well as editing and joining media files to create multimedia presentations for forming the Interactive Multimedia Application.

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Regarding claim 17, which is dependent on claim 16, as in claim 16, Syeda-Mahmood discloses one software interface to the software modules providing functionality other than access and rendering the multimedia files (such a server also directs interactive dialogue between the web client and multimedia database (col 4, lines 19-30)).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have utilized this feature of Syeda-Mahmood since Syeda-Mahmood provides an interactive dialogue, which is an interface, to perform the indexing on multimedia content, which is a function other than the access and rendering the multimedia files.

Independent claim 1 is a software Interactive Media Viewer module to perform one of the steps of the method disclosed in claim 16 (lines 19-24), therefore is rejected under the same rationale.

Claim 2, which is dependent on claim 1, is software module comprising one software interface to perform the method of claim 17, and therefore is rejected under the same rationale.

Independent claim 6 is a programming application to perform the method disclosed in claim 16, therefore is rejected under the same rationale.

Claim 7, which is dependent on claim 6, is a programming application to perform the method of claim 17, and therefore is rejected under the same rationale.



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9. Claims 3-5, 8-10, 11-12, 13-15, 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Syeda-Mahmood and Torres as applied to claim 16 above, and further in view of Goetz et al. (US Pat No. 5,956,729, 9/21/99).

Regarding claim 18, which is dependent on claim 16, Syeda-Mahmood and Torres do not disclose that the IMV is adapted to access and render multimedia code of only one type. Goetz discloses that an application may support several instances of a particular media type (col 3, lines 2-11). Even though Goetz fails to mention of the code for accessing and rendering of multimedia files, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have included Goetz to Syeda-Mahmood and Torres. The fact that Goetz shows the supporting of several instances of a particular media type implies that Goetz includes that type of code to perform such function.

Regarding claim 19, which is dependent on claim 16, Syeda-Mahmood and Torres do not disclose that the IMV is adapted to access and render multimedia code of more than one type. Goetz discloses that the invention includes a multimedia file for organizing at least one type of media on a computer-readable medium, such as a CD Rom, hard disk, or the like. The multimedia file is capable of storing and identifying multiple instances of at least one media type (col 3, lines 18-22).

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It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have incorporated Goetz to Syeda-Mahmood and Torres since Goetz further provides the access and rendering a multimedia file of at least one type, which means one type or more than one type of media.

Regarding claim 20, which is dependent on claim 16, Syeda-Mahmood and Torres do not disclose that the multimedia files stored in the data repository represent multimedia transactions, and are characterized with tags according to one or more of date, time, participants, file type; company affiliation of participants, subject or issue, and relationship to other multimedia files.

Goetz discloses:

-- the multimedia files represent multimedia transactions (a web page may allow to access to certain files stored on the server, including multimedia files. The web browser application invokes the novel multimedia client application which initiates an interaction with the multimedia server application to produce the multimedia file (col 11, lines 21-<sup>38</sup>~~26~~))

-- date, time, file type, subject and relationship to other multimedia files (the time of day as determined by a reference clock in the server (col 11, lines 61-66); the media request message sent to the multimedia server application, ..specifying the desired media type to be produced (col 11, lines 43-45); specifying the sizes and relationships of the information to be produced (col 12, lines 1-14)

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Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have incorporated Goetz to Syeda-Mahmood and Torres to provide the multimedia files as claimed in combination with the feature disclosed in claim 16 since Syeda-Mahmood and Torres show the accessing and rendering of the multimedia files as well as editing and joining media files to create multimedia presentations for forming the Interactive Multimedia Application, which are important points of a Multimedia Communication environment, and Goetz adds more features of multimedia files such as date, time, subject, and relationship to other multimedia files.

Claims 3-5 are IMV software modules to perform the method of claims 18-20, and therefore are rejected under the same rationale.

Claims 8-10 is a programming application to perform the method of claims 18-20, and therefore are rejected under the same rationale.

Independent claim 11 is for a multimedia communication center which includes the limitations of claim 6, the storage system for recording multimedia file (rejected in claim 20), and the access interface (Torres, col 1, lines 39-48; col 2, lines 5-34), therefore is rejected under the same rationale applied to these claims.

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Claim 12, which is dependent on claim 11, comprising software interfaces disclosed and rejected in claim 17 above, and therefore is rejected under the same rationale.

Claims 13-15 is a multimedia communication center including the IMV disclosed in the method of claims 18-20, and therefore are rejected under the same rationale.

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Shuster (US Pat No. 5,996,000, 11/30/99) teaches a method and apparatus for using distributed multimedia information.

Adams et al. (US Pat No. 5,737,495, 4/7/98) teaches a method and apparatus for managing multimedia data files in a computer network by streaming data files into separate streams based on file attributes.

Rogers et al. (US Pat No. 5,752,246, 5/12/98) teaches a service agent for fulfilling requests of a web browser.

Sasaki et al. (US Pat No. 5,774,583, 6/30/98) teaches an information reproducing device for reproducing multimedia information recorded in the form of officially readable code pattern, and information recording medium storing multimedia information in the same form.

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Zhu et al. (US Pat No. 5,768,527, 6/16/98) teaches a device system and method of real-time multimedia streaming.

Cohen et al. (US Pat No. 5,737,595, 4/7/98) teaches a distributed database system and database receiver therefor.

Kato (US Pat No. 5,809,512, 9/15/98) teaches an information provider apparatus enabling selective playing of multimedia information by interactive input based on displayed hypertext information.

Gustman (US Pat No. 5,813,014, 9/22/98) teaches a method and apparatus for management of multimedia assets.

Vertelney et al. (US Pat No. 5,202,828, 4/13/93) teaches an user interface system having programmable user interface elements.

Rose et al. (US Pat No. 5,752,244, 5/12/98) teaches a computerized multimedia asset management system.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cong-Lac Huynh whose telephone number is (703) 305-0432. The examiner can normally be reached on Monday through Friday from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Razavi, can be reached on (703) 305-4713. The fax number to this Art Unit is (703) 308-5403.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

12. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**or faxed to:**

(703) 308-9051, (for formal communications intended for entry)

**Or:**

(703) 308-5403 (for informal or draft communications, please label  
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,  
Arlington, VA., Sixth Floor (Receptionist).

clh

1/6/00

  
STEPHEN S. HONG  
PRIMARY EXAMINER